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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/392,476 09/09/99 WHITE

T 1039.2500-CI

005514 HM22/0428  
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EXAMINER

FRONDA, C

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

04/28/00

8

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/392,476

Applicant(s)

White et al.

Examiner  
Christian L. Fronda

Group Art Unit  
1652



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-30 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-30 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1652

## DETAILED ACTION

### *Claim Objections*

1. Claim 2 is objected to because of the following informalities:
  - A. The phrase "wherein the gene interest" is incorrect. It should be written as "wherein the gene of interest". Appropriate correction is required.
  - B. The names "*eg1*, *eg2*, *eg3*, *eg5*" designating the genes encoding endoglucanases is incorrect. The correct names of the genes are "*egl1*, *egl2*, *egl3*, *egl5*". Appropriate correction is required.

### *Claim Rejections - 35 U.S.C. § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The meaning of the phrase "pharmaceutical, nutraceutical, industrial, an animal feed, a food additive" is uncertain. The specification fails to define these terms.

### *Claim Rejections - 35 U.S.C. § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Suominen *et al.* (see entire publication of WO93/24621). These claims are anticipated by Suominen *et al.* because Suominen *et al.* teach claims 1-30.

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In Example 4, pp.61-63, and Figure 11 of WO93/24621, Suominen *et al.* teach an isolated nucleotide sequence comprising a *cbh1* promoter (see also claim 10, p. 85), an intervening sequence, *xln1* signal secretion sequence, and *xln1* gene; a vector comprising the said nucleotide sequence, a terminator sequence, and a marker gene (see also p.12, lines 8-260); and transformed *Trichoderma* ssp. and other transformed filamentous fungi species (see claim 14, and p. 6, line 10-13). In Example 4, pp.61-63 of WO93/24621, Suominen *et al.* teach a method for producing the protein encoded by the *xln1* gene and other proteins or enzymes (see also p. 14, lines 19-29); purification of the protein (see also p. 35, lines 13-28); and removing the pre-prosequence (see also p.35, lines 13-28 and p. 49, lines 13-30). Furthermore, Suominen *et al.* teach that the xylanase secretion sequence is heterologous or homologous with respect to the filamentous fungi (see **Regulatory Regions**, p. 26-27).

### Conclusion

4. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. The fax phone number for this Group is (703)308-0294. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF  
April 24, 2000



PONNATHAPU ACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
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